

REMARKS

Applicant requests favorable reconsideration of this application in view of the foregoing amendments and the following remarks. Claims 1-25 were pending and were rejected in the Office Action. By way of this Amendment, Applicant has cancelled claim 24, without prejudice or disclaimer. Accordingly, claims 1-23, and 25 are respectfully presented for further consideration.

Applicant appreciates the Examiner's withdrawal of the previous rejections in response to Applicant's previous arguments.

1. Information Disclosure Statement

Applicant respectfully requests an indication that the Examiner has considered each of the references submitted with the Information Disclosure Statement ("IDS") filed on November 18, 2004. Of course, such an indication may be provided by way of Examiner initials on the form PTO/SB/08 that was submitted along with the IDS.

2. Rejection of Claim 24 under 35 U.S.C. § 112, ¶ 2

The Office Action rejected claim 24 under 35 U.S.C. § 112, ¶ 2 as allegedly "being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Applicant respectfully submits that this rejection is now moot due to the cancellation of claim 24, without prejudice or disclaimer. Accordingly, a withdrawal of this rejection is both warranted and earnestly solicited.

3. Rejections of Claims 1-25 under 35 U.S.C. § 103(a)

The Office Action rejected: (a) claims 1-19 and 21-25 under 35 U.S.C. § 103(a) as allegedly being obvious when considering U.S. Patent No. 4,810,084 ("Nyui") in view of U.S. Patent No. 6,305,801 ("Kerns"); and (b) claim 20 under 35 U.S.C. § 103(a) as allegedly being obvious when considering Nyui in view of Kerns and further in view of U.S. Patent No. 6,271,968 ("Dobrowolski"). Preliminarily, the rejection of claim 24 is now moot due to the cancellation of claim 24, without prejudice or disclaimer. Accordingly, these rejections will be addressed, and respectfully traversed, with respect to claims 1-23 and 25.

A. Claims 1-19, 21-23, and 25

Claim 1 continues to recite an optical device that includes, among other possible things:

a light source emitting light along an illuminating beam having a two-dimensional cross-sectional area;
a main objective;
a spectral filter positioned between the light source and the main objective,

wherein the spectral filter is adapted to reduce, without eliminating, the intensity of the light emitted by the light source in a specific region, the specific region being a subsection of the two-dimensional cross-sectional area of the illuminating beam.

In rejecting claim 1, the Office Action acknowledges that Nyui fails to teach or suggest a spectral filter that satisfies each of the limitations of claim 1. To cure this deficiency, the Office Action relies on Kerns. However, as later explained in detail, M.P.E.P. § 2143.01 bars the combination of Nyui and Kerns.

Before turning to the impropriety of the combination of Nyui and Kerns, Applicant notes another fault in the stated rejection. Specifically, Nyui teaches an optical device that includes an illuminating light source 6 and a filter 20. Contrary to the Office Action's assertion, however, Nyui's eyeball 4 (which is separated from the optical device) clearly cannot be considered to be an objective that is part of the optical device. Accordingly, for the sake of argument, Applicant assumes that the Office Action intended to analogize Nyui's objective lens 13, which is part of Nyui's optical device, to the objective recited in claim 1. However, even assuming, *arguendo*, that the Office Action intended to analogize Nyui's objective lens 13 to the objective recited in claim 1, the rejection is still flawed because M.P.E.P. § 2143.01 bars the combination of Nyui and Kerns.

One of the obviousness requirements set forth in the M.P.E.P. § 2143.01 dictates that for two (or more) references to be combined under 35 U.S.C. § 103(a), the teachings in the references must work together in such a way that the proposed combination does not change the principle of operation of the references. Nyui teaches a retinal camera that uses a filter 20 that transmits a *constant* amount of light. In contrast, the contact lens disclosed in Kerns transmits a *variable* amount of light, *i.e.*, the amount of light transmitted depends on ambient lighting conditions. *See* Kerns at Abstract; col. 6, lines 2-7. Moreover, a basic principle of operation of Kerns is that the Kerns contact lens must work in combination with a pupil that dilates (col. 6, lines 1-8).

As one of ordinary skill in the art would not replace Nyui's constant filter with the Kerns' variable filter or apply Kerns to a situation that has no pupil, the references can not be combined to reject claim 1, or any claim dependent thereon, under 35 U.S.C. § 103(a). Moreover, as claims 2-19, 21-23, and 25 depend from claim 1, each of these dependent claims is also allowable over Nyui and Kerns, without regard to the other patentable limitations recited therein. Accordingly, a withdrawal of the rejection of claims 1-19, 21-23, and 25 is both warranted and respectfully requested.

B. Claim 20

Claim 20 depends from claim 1 and, therefore, recites each of the limitations of claim 1. As previously discussed, Kerns can not be used to cure the admitted deficiencies of Nyui with respect to claim 1. Moreover, Dobrowolski, which teaches cut-off filters that lack localized differences in the amount of light transmitted, fails to cure Nyui's deficiencies.

Accordingly, as the combination of Nyui and Dobrowolski fails to teach or suggest each of the limitations of claim 1, the combination can not be used to reject claim 1, or any claim dependent thereon, under 35 U.S.C. § 103(a). Moreover, as claim 20 depends from claim 1, claim 20 is also allowable over the combination of Nyui and Dobrowolski (and Kerns), without regard to the other patentable limitations recited therein. Therefore, a withdrawal of the rejection of claim 20 is both warranted and earnestly solicited.

CONCLUSION

For the aforementioned reasons, claims 1-23, and 25 are now in condition for allowance. A Notice of Allowance at an early date is respectfully requested. The Examiner is invited to contact the undersigned if such communication would expedite the prosecution of the application.

Respectfully submitted,

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THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY ADDITIONAL FEES WHICH MAY BE REQUIRED REGARDING THIS APPLICATION UNDER 37 C.F.R. §§ 1.16-1.17, OR CREDIT ANY OVERPAYMENT, TO DEPOSIT ACCOUNT NO. 19-0741. SHOULD NO PROPER PAYMENT BE ENCLOSED HEREWITH, AS BY A CHECK BEING IN THE WRONG AMOUNT, UNSIGNED, POST-DATED, OTHERWISE IMPROPER OR INFORMAL OR EVEN ENTIRELY MISSING, THE COMMISSIONER IS AUTHORIZED TO CHARGE THE UNPAID AMOUNT TO DEPOSIT ACCOUNT NO. 19-0741. IF ANY EXTENSIONS OF TIME ARE NEEDED FOR TIMELY ACCEPTANCE OF PAPERS SUBMITTED HEREWITH, APPLICANT HEREBY PETITIONS FOR SUCH EXTENSION UNDER 37 C.F.R. § 1.136 AND AUTHORIZES PAYMENT OF ANY SUCH EXTENSIONS FEES TO DEPOSIT ACCOUNT NO. 19-0741.